

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, tentatively rejected all pending claims 7-19. In this response, independent claim 14 has been canceled and new claim 20 has been added.

Discussion of Rejections Under 35 U.S.C. 102(b)

The Office Action tentatively rejected claims 7, 9, 12, 14-15 and 17 under 35 U.S.C. 102(b) as allegedly unpatentable over McNamara Jr (U.S. 4,047,076). For at least the reasons set forth below, Applicant respectfully disagrees.

Independent claim 7 recites:

7. An electronic device having an illumination circuit, comprising:
a first load, wherein a current flowing on the first load is reduced as time increased;
an AC driving unit for generating an AC current to drive the first load;
a current transformer having a primary winding and a secondary winding, wherein the primary winding is coupled between the first load and the AC driving unit, such that the secondary winding generates an induced current;
a second load having an illumination function, wherein brightness of the second load is changed according to an AC driving voltage and wherein the brightness of the second load corresponds to an operating duration of the first load; and
a transformation device, connected with the secondary winding and the second load in parallel, for transforming the induced current to the AC driving voltage to drive the second load.

(Emphasis added.) Applicant submits that the cited art fails to disclose at least those features emphasized above.

As emphasized above, the transformation device of the claimed embodiment is connected with the secondary winding and the second load in parallel. In page 3, the Office Action alleged that element 70 (shown in Fig. 11 of McNamara) corresponds to the transformation device of the claimed embodiment. However, as illustrated in Fig. 11 of McNamara, the element 70 is not

directly connected with right part of the element 30 and element 32 in parallel. Therefore, McNamara does not teach or suggest that the transformation device of the claimed embodiment is connected with the secondary winding and the second load in parallel.

For at least this reason, claim 7 patently defines over the cited reference. Insofar as claims 8-13 depend from claim 7, these claims define over the art as well.

Similarly, McNamara does not disclose the transformation device in amended claim 1. In this regard, claim 14 recites:

14. An electronic device having an illumination circuit, comprising:
a first load;
an AC driving unit for generating an AC current to drive the first load;
a current transformer having a primary winding and a secondary winding,
wherein the primary winding is connected with the first load in parallel and
coupled to the AC driving unit such that the secondary winding generates an
induced current;
a second load having an illumination function; and
***a transformation device connected with the secondary winding and
second load in parallel*** for transforming the induced current to the AC driving
voltage to drive the second load.

(Emphasis added.) Applicant submits that the cited art fails to disclose at least those features emphasized above. In this regard, the emphasized feature of amended claim 14 patently defines over McNamara for the same reasons as claim 1 (discussed above). Insofar as claims 15-19 depend from claim 14, claims 15-19 are allowable for at least the same reasons.

Patentability of new claim 20

Among other features, new claim 20 recites: "the impedance and the low-pass filter are connected with the secondary winding and second load in parallel." This feature is neither disclosed nor suggested by the cited art of record.

Discussion of Rejections Under 35 U.S.C. 103(a)

The Office Action rejected claim 10 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of McNamara in view of U.S. patent 4,590,600. Likewise, the Office Action rejected claims 8 and 19 10 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of McNamara in view of U.S. patent 4,358,712. The Office Action also rejected claims 13 and 18 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of McNamara in view of U.S. patent 6,426,597. As set forth above, Applicant respectfully submits that each of these claims patently defines over the cited art of record, at least by virtue of their dependency from allowable independent claims. For at least this reason, these rejections should be withdrawn.

As a separate and independent basis for the patentability of claims 8, 10, 13, 18, and 19, Applicant submits that the Office Action has failed to identify a proper suggestion or motivation to combine the selective teachings of the various references. In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to realize an electronic device with an illumination circuit, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998);

Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion is "essential" to avoid hindsight. In re Fine, 837 F.2d 1071, 1075 (Fed.Cir.1988). A description of the particular "teaching or suggestion or motivation [to combine]" is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, "the [Examiner] must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." In re Rouffet, 149 F.3d 1350, 1359 (Fed.Cir.1998). The Examiner can satisfy this burden of establishing obviousness in light of combination "only by showing some objective teaching [leading to the combination]." In re Fritch, 972 F.2d 1260, 1265 (Fed.Cir.1992).

In combining *Beeman* with *McNamara*, the Office Action merely concluded that it would have been obvious "because low pass filter removes the high frequency interference and this is an important issues especially after signal is amplified...." (Office Action, p. 5). In combining *Filgas* with *McNamara*, the Office Action alleged that the combination would have been obvious "because the second load (main load) requires a lot of power, therefore there is a need for a

transformer that have step-up capability.” (Office Action, p. 5). Further, in combining *Rast* with *McNamara*, the Office Action alleged that the combination would have been obvious “because EL is commercially available type of a discharge lamp, furthermore it produces very bright light, what in most application for which lighting is used, it is a desirable feature.” (Office Action, p. 6).

These bases are clearly improper, as such conclusory, result-oriented bases could be used to rejected virtually any patent claim on an improvement system that results in a device or method that is realizes some perceptible improvement over the prior art. Improvements of this sort are the very basis that underscores the purpose of the patent system (e.g., the improvement of technology), and the rejection embodies clear (and improper) hindsight reasoning.

Simply stated, the Office Action has failed to comply with these legal standards. Consequently, the rejections of the respective claims are legally improper and must be withdrawn.

Cited Art

The cited art made of record, but not relied upon, has been considered but is not believed to impact the patentability of the pending claims.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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